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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-584

MARY HELEN SEARS,
*Petitioner,*

v.

ROBERT GOTTSCHALK, Commissioner of Patents,
*Respondent.*

**PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT**

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## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioner prays that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit entered in this proceeding on August 14, 1974.

## THE OPINIONS BELOW

The opinion of the Court of Appeals is reported at 502 F.2d 122 and is reproduced as Appendix A, *infra*, p. 1a. The opinion of the district court is reported at 357 F. Supp. 1327 (E.D.Va. 1973) and is reproduced as Appendix B, *infra*, p. 20a.

## JURISDICTION

The opinion of the Court of Appeals for the Fourth Circuit was filed on August 14, 1974. A timely petition

for rehearing was denied on September 17, 1974, Appendix C., *infra*, p. 27a, and this petition for writ of certiorari was filed within 90 days of that date. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## QUESTIONS PRESENTED

1. Exemption 3 of the Freedom of Information Act provides for nondisclosure of "matters that are specifically exempted from disclosure by statute". The question is whether this exemption covers all material with respect to which Congress by statute has provided for nondisclosure upon various terms, including statutes that give government officials discretion to decide whether to disclose.[1]

(a) Specifically, is 35 U.S.C. § 122 a "statute" by which abandoned patent applications are "specifically exempted from disclosure" within the meaning of Exemption 3?

2. Does *Brown* v. *Guild*, 90 U.S. 181 (1874), which recognized that abandoned applications have "a bearing on the question of prior invention or discovery" and hence are properly included in the "whole of the evidence" germane to patent validity but held a particular abandoned application describing an abandoned experiment not *per se* dispositive of the validity issue, justify excluding abandoned applications from the evidence considered by the Patent Office in determining patentability under 35 U.S.C. §§ 102 and 103?

3. Are abandoned applications "necessary to carry out the provisions of any act of Congress" including 35 U.S.C. §§ 102 and 103 and hence disqualified from secrecy by the very terms of 35 U.S.C. § 122?

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[1] This question is identical with the single question in No. 74-450. *Robertson* v. *Butterfield*, filed October 18, 1974. It arises, however, in the context of an entirely different statute. The concurrent presentation of the two petitions affords an excellent opportunity for precise definition of the reach of exemption 3. See *infra*, p. 19.

4. Does the Constitution's requirement for strict adherence to the criteria for patentability now codified in Title 35 preclude the Patent Office from promulgating regulations by which abandoned applications are categorically excluded from (i) public availability and (ii) consideration as evidence germane to patentability? [2]

## CONSTITUTIONAL PROVISIONS, STATUTES AND PATENT OFFICE RULES INVOLVED

This case involves the Patent Clause, Art. I, § 8, Cl. 8 and the Supremacy Clause, Art. VI, § 2, of the Constitution; the Fifth Amendment, 5 U.S.C. §§ 552(a)(3), (b)(3) and (c); and 35 U.S.C. §§ 6, 102(a) and (b), 103, 131 and 282 and Patent Office Rules 14 (37 C.F.R. 1.14) and 108 (37 C.F.R. 1.108).

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[2] As held in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and restated in *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969), the patentability "*standard* expressed in the Constitution . . . may not be ignored. And it is in this light that patent validity 'requires reference to a standard written into the Constitution.' A.&P. Tea Co. v. Supermarket Corp., *supra*, 340 U.S. at 154 . . .". The constitutional patent clause "is both a grant of power and a limitation", a "qualified authority . . . limited to the promotion of advances in the 'useful arts' "; the "Congress in the exercise of the patent power may *not* overreach the restraints imposed by the stated constitutional purpose". *Only* "[w]ithin the scope established by the Constitution, Congress may set out conditions and tests for patentability". 383 U.S. at 5, 6. 35 U.S.C. § 103 "comports with the constitutional strictures", *id.* at 17, *only* if construed and applied in a manner to implement and not to denigrate the constitutional patentability standard. It is stipulated that "the constitutional standard for patentable invention . . . [is] now codified in 35 U.S.C. § 103". C.A. App. I.*; p. 42, Par. 23.

See generally "The Consitutional Standard of Invention—The Touchstone for Patent Reform," 1973 Utah L. Rev. 653.

* The Appendix in the Court of Appeals, a copy of which has been lodged with the Clerk, is in two volumes cited as "App. I" and "App. II"

5 U.S.C. §§ 552(b)(3) and (c) and 35 U.S.C. § 122 are reproduced below. The remaining provisions appear in Appendix D, *infra*, p. 28a.

*5 U.S.C. § 552(b)(3)*

> "(b) This section does not apply to matters that are —
>
> * * * *
>
> (3) specifically exempted from disclosure by statute;"

*5 U.S.C. § 552(c)*

> "(c) This section [552] does not authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section. . . ."

*35 U.S.C. § 122*

> "Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

## STATEMENT OF THE CASE

Petitioner, an experienced patent lawyer, invoked the Freedom of Information Act (FOIA) to obtain access to the files of abandoned patent applications maintained in secrecy at the Patent Office.[3] The Patent Commis-

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[3] It is stipulated that

> "4. For the purpose of this case the expression 'abandoned United States patent applications' means all documents in the Patent Office files of all existing applications for United States letters patent, prosecution of which terminated without the issuance of a patent thereon (Complaint Par. 6).
>
> "6. . . . If the application becomes abandoned, it is the entire record contained in the file wrapper which is forwarded to the

sioner refused petitioner's request on the stated ground "that access is barred under 35 U.S.C. § 122" and "that, therefore, the provisions of 5 U.S.C. § 552(a)(3) did not apply in view of the exemption afforded by 5 U.S.C. § 552(b)(3)".[4]

Abandoned patent applications, which first assumed importance with the 1836 establishment of the Patent Office,[5] were initially made freely accessible to the public and were applied by the Patent Office as evidence germane to determining patentability of the claims presented in cases pending before it. They were equally utilized by the courts as evidence germane to patent validity, in the same manner in which the courts still apply them.[6]

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abandoned files. Thus, the term 'abandoned application' has reference to the entire contents of the file wrapper, and not merely to the original applications papers, as filed." (C.A. App. I, p. 34.)

[4] Petitioner's request was denied by the Patent Office and the district court on the additional ground that it was not for "identifiable records" within the meaning of § 552(a)(3). The court of appeals rejected this contention.

The Commissioner also stated that "in reliance upon" § 122 "inventors make full disclosures of their inventions with the assurance that valuable trade secrets therein will be disclosed only at the inventor's option". In the district court, the agency claimed, and the district court sustained, exemption on "trade secret" grounds under § 552(b)(4). The court of appeals did not reach the §(b)(4) issue, and it is not discussed herein.

The agency refusal of petitioner's request is Exhibit A of the FOIA complaint in this action, C.A. App. I, p. 13, 21.

[5] During most of the patent system's prior existence—*i.e.*, from 1793 to 1836—all patent applications were automatically issued and published with questions of patentability consigned to the courts for post-publication determination.

[6] See, e.g., from this Court *Brown* v. *Davis*, 116 U.S. 237 (1886); *Yale Lock Mfg. Co.* v. *Greenleaf*, 117 U.S. 554 (1866); *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U.S. 477 (1935); *Stelos Co.* v. *Hosiery Motor-Mend Corp.*, 295 U.S. 237, 242 (1935); *Smith* v. *Hall*, 301 U.S. 216 (1937), holding that an unpublished abandoned patent application "is competent and cogent evidence

In 1874, this Court in *Brown* v. *Guild*, 90 U.S. 181, specifically acknowledged that abandoned applications have "a bearing on the question of invention or discovery" and hence are properly included in the "whole of the evidence" germane to patent validity. It determined, however, that the particular abandoned application before it described a "mere experiment" instead of a completed invention and hence that it did not *per se* establish the defense of prior public use or prior invention by another under the then extant predecessor of 35 U.S.C. § 102.

The Patent Office eventually seized upon *Brown* as an excuse to discontinue absolutely the citation of abandoned applications as evidence of unpatentability[7] and hence to expediently restrict the practice of routinely laying the files of such applications freely open to the public for

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to determine the nature and state of the invention which the inventor claims to have embodied in workable form", 301 U.S. at 227; and from the lower federal courts *Package Devices, Inc.* v. *Sun Ray Drug Co.*, 301 F.Supp. 768 (E.D.Pa. 1969), aff'd 432 F.2d 272 (3 Cir. 1970). See, e.g., *James B. Clow & Sons, Inc.* v. *United States Pipe & Foundry Co.*, 313 F.2d 46 (5 Cir. 1963); *Carrier Mfg. Co.* v. *Rex Chainbelt, Inc.*, 281 F.Supp. 717 (E.D.Wis. 1968).

[7] Even the Patent Office recognized, *at the time Brown* v. *Guild was decided in 1874*, that it was not "controlling" but held only that *prima facie* prior invention as evidenced by an abandoned patent application, like any other form of *prima facie* evidence, can be rebutted. It was not until December of 1879 that the agency invoked *Brown* v. *Guild* as a pretext for discontinuing as *inconvenient* the consideration of abandoned applications in the examination of pending cases.

As late as May 1879, five years after *Brown* v. *Guild*, Patent Office Rule 171 stated:

> ". . . Abandoned and forfeited applications will be cited as references in all cases where no earlier reference can be found, and they will be considered *prima facie* evidence of prior invention of the novel and patentable matters *clearly* set forth and shown therein."

On December 1, 1879 Rule 171 was amended to state in part, "[f]orfeited and abandoned applications will not be cited as references".

*inspection in the Patent Office.* As stipulated in the district court, "It is convenient for the Patent Office not to maintain all abandoned applications available for public inspection" (C.A. App. I, 44).[8]

This Court, in 1926, criticized this Patent Office practice and strongly implied that abandoned applications are competent and even necessary evidence on the issue of prior inventorship, but did not rule upon its legitimacy

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[8] As noted in Doerfer, "The Limits on Trade Secret Law Imposed by Federal Patent and Antitrust Supremacy", 80 Harv. L. Rev. 1432, 1446, n. 94 (1967):

> "The Patent Office did lay open to public inspection all applications after final action until 1876, after the decision in The Cornplanter Case, 90 U.S. (23 Wall.) 181 (1875), . . . . Certain features of the prior [abandoned] application represented no more than an abandoned experiment, and hence not a true anticipation. The Court was not apprised of the Patent Office practice of laying abandoned applications open to the public and hence did not base its decision on the grounds of prior disclosure in a printed publication. The Office, however, took the decision as a disapproval of its practice, and discontinued it. Orenbuch, Abandoned Applications as Prior Art, 45 J. Pat. Off. Soc'y 613 (1963)."

Importantly, however, the Patent Office did *not* relegate abandoned patent applications to the "secret" category but adopted a rule which in substance remained in effect until 1949 pursuant to which copies of such applications were furnished on request, in contrast to pending applications which were at all times expressly classified as "secret" in a separate rule.

As late as 1954, the Patent Office recognized the pre-1949 dichotomy by which the "rule of secrecy" applied *only* to pending and not to abandoned applications. See "Plaintiff's Exhibit III", C.A. App. I, 57.

The apposite Rules of 1879 provided in pertinent part:

> "15. Caveats and *pending* applications are preserved in secrecy . . ."
>
> "171. . . . Certified copies of the files in cases of . . . abandoned applications may be furnished to applicants or to other persons when ordered, but no inspection of such files [in the Patent Office] except by applicants or their duly authorized agents will be permitted."

because the issue was not presented. See *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U.S. 390.[9]

There are some 600,000 abandoned patent applications which contain evidence germane to patentability—none of which is now considered by the Patent Office in the dis-

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[9] In *Milburn* the losing party urged that by analogy to this Patent Office practice only issued patents could be considered as evidence of prior inventorship to defeat a patent. As the Court expressed it, ". . . since the decision in the case of The Corn-Planter Patent (Brown v. Guild) . . . it is said, at all events for many years, the Patent Office has made no search among abandoned patent applications. . . ." 270 U.S. at 400.

This Court characterized such agency "disregard of abandoned patent applications, however explained . . . [a]s an empirical rule, no doubt convenient . . . if not necessary to the Patent Office", 270 U.S. at 402. Saying further that "we are not disposed to disturb it, although we infer that originally the practice of the Office was different", the Court cautioned that the agency practice "cannot be taken to establish a principle beyond the rule as actually applied", but must bow to "[t]he fundamental rule . . . that the patentee must be the first inventor" application of which is not prevented by "qualifications in aid of a wish . . . to avoid laborious investigations." (270 U.S. 402). Under that fundamental rule, now codified in 35 U.S.C. 102(e), United States patent applications are competent evidence of prior inventorship by another as of their filing dates. See *Hazeltine* v. *Brenner*, 382 U.S. 252 (1965).

The Court's disinclination to disturb the criticized Patent Office practice is, of course, attributable to the fact that the practice was *not per se* in issue. Further, the Court's characterization of the Patent Office practice in *Milburn* as "convenient" and "in aid of a wish to avoid . . . laborious investigation" is fairly attributable to concern expressed in the brief *amicus curiae* of ex-Commissioner Ewing that the resumption of the *prior* practice of considering abandoned applications as references would be burdensome for the agency. Mr. Ewing's acknowledgement that abandoned applications contain "anticipatory material which would vastly increase the uncertainty . . . as to the validity of any patent" is strikingly analogous to agency acknowledgement *in this case* that "At least some abandoned United States applications are evidence of the level of skill in the art to which they pertain as of their filing dates" (C.A. App. I, p. 35; par. 12). Contrast these admissions with the requirements of §§ 102 and 103 and the *Milburn* "fundamental rule" which make no exception for abandoned applications.

charge of its duties under 35 U.S.C. 131.[10] But for the "secrecy" now imposed by the agency under 37 CFR 1.108 and 1.14 on the presumed authority of § 122,[11] enacted in 1952, all of this evidence necessarily would be considered in evaluating later filed applications against the controlling patentability standards imposed by the Constitution and the patent laws. As the agency itself puts it, ". . . non-reliance by the Patent Office upon abandoned applications and preserving them in secrecy are opposite sides of the same coin".[12]

Deeming it anomalous that the Patent Office should so disqualify itself to perform fully its sole legitimate function of weeding out unpatentable subject matter and, by secrecy, inhibit the courts in their function of fully assessing patent validity, petitioner proceeded under § 552(a)(3) to seek a *de novo* determination in the district court of public accessibility to the abandoned applications.

The complaint (C.A. App. I, p. 13) affirmatively alleges that § 122 is not a "statute" which "specifically exempts" abandoned patent applications from production within the meaning of the FOIA's exemption 3. *Per contra*, as par. 11 of the complaint states, § 122 is disqualified as a § b(3) exemption statute by its *own* mandate that applications "necessary to carry out the

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[10] 35 U.S.C. § 131 requires that the Commissioner, as part of his duties, "shall cause an examination to be made" of applications for patents and to issue a patent on such applications only "if on such examination it appears that the applicant is entitled to a patent under the law".

[11] Under 35 U.S.C. 6 the Commissioner "may, subject to the approval of the Secretary of Commerce establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

[12] The quotation is from defendant's "Memorandum in Opposition to Plaintiff's Petition to Impanel Three-Judge District Court . . ." filed May 12, 1972 in the district court.

provisions of any act of Congress" are *not* subject to its "confidence" provisions.[13]

The complaint also states that "Public access to abandoned patent applications and consideration of such applications by the Patent Office and the courts is essential to insure that the patent system operates in a manner consistent with the constitutional objective" (Par. 17, C.A. App. I, p. 17), *inter alia*, because such applications contain evidence germane to the issues of patentability and patent validity upon which the agency and courts are required to pass (Par. 12-16, C.A. App. I, pp. 14-17). For these reasons, among others, the complaint states that "35 U.S.C. § 122 as construed by the defendant in this case to deny public access to the abandoned U.S. patent applications and thus to preclude consideration of the evidence of unpatentability contained therein by the Patent Office and the courts" is invalid under the patent, supremacy and due process clauses. See, *e.g.*, paragraphs 15 and 18 to 22, C.A. App. I, pp. 16-18.

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[13] Paragraphs 10 and 11 of the complaint state:

> "10. Access by plaintiff and the public to the requested abandoned United States patent applications is not barred by 35 U.S.C. 122 which in pertinent portion states:
>
> > 'Applications for patents shall be kept in confidence by the Patent Office . . . unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.'
>
> and hence are not exempted by 5 U.S.C. 552(b)(3) and are subject to production under the provisions of 5 U.S.C. 552 (a)(3).
>
> "11. Availability of the requested abandoned United States patent applications to the public is 'necessary to carry out the provisions' of at least 35 U.S.C. 102(a), 102(f), 103 and 282 and of Article 1, Section 8, Clause 8 of the Constitution of the United States." (C.A. App. I, p. 14)

Paragraphs 12 through 17 set forth specific reasons why availability of abandoned applications to the public "is necessary to carry out the provisions" of the various statutes and the Constitution as alleged in Paragraph 11.

On May 12, 1972, the district court denied petitioner's application to appoint a three judge court pursuant to 28 U.S.C. 2284 (C.A. App. I, 25, 27). It never ruled on petitioner's renewed application filed June 9, 1972 (C.A. App. I, 28). At the "trial" ultimately held on August 16, 1974, no witnesses were called by either party. The court ruled upon offers of evidence [14] and heard oral argument.

On August 28, 1974, twelve days after the trial was concluded, the agency filed a "Motion to Reopen Trial under Rule 59(a)(2)" App. I, 10 *inter alia* to present 45 new exhibits.[15] On September 5, 1972, plaintiff filed its "Opposition", pointing out that the 45 exhibits were in no sense "newly-discovered" evidence and that, if the motion were granted "at the very least, a reopening of proceedings would necessarily be required" to permit petitioner to elicit counter-evidence.

The district court never ruled on the agency's Rule 59(a)(2) motion. However, its April 26, 1973 "Memo-

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[14] Among other things, the district court expressly ruled that it would not use "anything" in the agency's Exhibit Book I (a collection of decisions in the 1890-1904 time period) (Tr. 162-164) as evidence of the Patent Office practice regarding the public availability of abandoned applications.

Petitioner's objection is obviously valid and was properly sustained by the district court. The Patent Office—again on the presumed authority of § 122—has suppressed approximately 175 bound volumes of its "manuscript decisions" plus unspecified numbers of unbound decisions and has selected for publication only those few which suit its purposes. See *Irons* v. *Schuyler*, 465 F.2d 608, 613 (D.C. Cir. 1972). Against this mass of secret law, the decisions cited below were correctly rejected as *evidence* by the district court and improperly considered as evidence prejudicial to the petitioner by the court of appeals. Appendix A, p. 14a.

[15] Including an allegedly "volunteered" *ex parte* affidavit of Pasquale J. Federico, a retired Patent Office sinecurist who at all relevant times was resident in the Washington, D.C. area available to be called by the Patent Office as a witness, albeit subject to proper cross examination.

randum Opinion and Order", *infra*, Appendix B, p. 20a, deciding in favor of the Patent Office on all issues and dismissing the complaint was clearly influenced by the "new evidence" which petitioner was denied an opportunity to meet.[16] In derogation of 28 U.S.C. 2284, the April 26, 1973 "Order" adjudicates the merits of petitioner's constitutional claims (App. B, p. 25a)

An appeal was timely noticed, and on June 29, 1974, petitioner filed a motion for summary reversal on the ground that the district court was without jurisdiction to dismiss the complaint on its merits in lieu of convening a three-judge court pursuant to 28 U.S.C. §§ 2282 and 2284. The summary reversal motion was "denied" without explanation by a single judge on November 11, 1973. Oral argument was had on March 6, 1974 and the appellate opinion affirming the judgment of the district court was filed August 14, 1974.

The appellate opinion pays lip service to the settled doctrine that "there must be strict compliance with [§ 552 (b) (3)'s] requirement that a matter be '*specifically* exempted' from disclosure by statute" (App. A; p. 11a) (emphasis in original)—it nonetheless holds that § 122 qualifies under exemption 3 to "specifically exempt" *abandoned* patent applications to which the statute does not advert, saying that:[17]

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[16] The district court's opinion states:

> "At least twenty four percent contain trade secrets which the applicants desire to maintain in secrecy." (App. B; p. 22a)

This finding is taken almost verbatim from the memorandum filed in support of the agency's August 28, 1972 Rule 59(a)(2) motion which states:

> "Assuming none of the missing responses favors defendant's position in 6 of our 25 cases, or 24% of the random sample selected, an abandoned application did contain a trade secret at the time it became abandoned." (p. 10).

[17] Essential to its ruling that abandoned applications are "specifically" subject to § 122's confidence provisions is the Fourth Circuit's assertion that "[t]he language in § 122 creating confiden-

"The *presence of guidelines* for the exercise of discretion to withhold or disclose *qualifies* a statute to be the basis of a (b)(3) exception. The phrase [in

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tiality speaks of [a]pplications for patents. The language is broad enough to include all categories of applications—pending, abandoned and granted . . ." (App. A, 11a)—a conclusion urged by petitioner to be fallacious because the files of "granted" applications (*i.e.*, applications which issue as patents) are now and have always been open to the public.

The Fourth Circuit's unpersuasive answer is that the publication of the files of granted patents "results from the provisions of §§ 112 and *154 and not from the provisions of § 122*." (App. A, 11a, n. 14) —an answer contradicted by Raymond Martin, the assistant Patent Office Solicitor of record below, who has stated:

> "The Commissioner has delegated administration of Section 122 to the Solicitor, who in turn has delegated it to an associate solicitor.
>
> "In the exercise of his discretion, the Commissioner has determined by rule that certain Patent Office records are open to the public as a matter of right. These are set forth in Rules 11 and 14(b). Thus, the file of a patented application is open to the public as is the file of a terminated interference involving a patent, or an application on which a patent has subsequently issued. These are provided for in Rule 11(a)." Martin, The Functions of the Office of the Solicitor of the United States Patent Office, Vol. 56, Journal of the Patent Office Society, 30, 36 (1974).

Section 154 is in terms inapposite, requiring only that "A copy of the specification and drawings [not the whole file] shall be annexed to the patent and be a part thereof".

This Fourth Circuit holding was designed to meet petitioner's argument that § 122's language "[a]pplications *for* patents" defines *only* pending applications which *alone* seek the grant of patents. It was an essential part of the erroneous assertion that "if" petitioner's argument that abandoned applications are *not* "specifically excluded" by § 122 "prevails, FOIA plaintiffs will be able to compel public disclosure of all applications both pending and abandoned . . . ." (App. A, 6a, note 8).

The Fourth Circuit carefully ignored petitioner's further contention that *if* section 122 includes *all* applications, then both issued and abandoned applications, being "necessary to carry out the provisions of" other parts of the Patent Act, are not subject to the Commissioner's discretion and must be made publicly available.

§ 122] 'such special circumstances as may be determined by the Commissioner' is such a standard. It incorporates the then existing *administrative standards* embodied in Rule 14(a) and (b).[12] *In turn*, the standards found in Rule 14 are sufficiently specific that they meet the 'specifically exempting' requirement of the (b)(3) exception."

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[12] 37 C.F.R. 114(a), (b)." [18]

In thus qualifying § 122 under FOIA exemption 3, the appellate court pointedly ignored the statute's *own* exemption from its confidence provisions of *all* applications "necessary to carry out the provisions of any act of Congress." [19]

It never discussed the evidentiary requisites of §§ 102 and 103 relative to *this* explicit § 122 clause, but relegated to the constitutional context all of petitioner's arguments concerning those criteria and the statutes [20] which direct the Patent Office and the lower courts to implement them. The constitutional arguments—which need not have been reached if the § 122 "necessary to carry out" clause had been carefully analyzed—were then misstated and summarily pronounced "insubstantial".

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[18] A ruling which conflicts with decisions from other circuits to the effect that a statute which confers *discretion* upon the agency to determine whether to make agency records available does *not* qualify under exemption 3. See the discussion of these cases in the petition in No. 74-450 and as amplified, *infra*, p. 19.

[19] In Part VI of its opinion App. A, p. 11a, the lower court, to qualify § 122 as "specifically exempting" abandoned applications even under its own newly fashioned "test", relied upon *de novo* appellate fact findings premised on evidence rejected or improperly considered below including the agency's "Exhibit Book I" (n. 14, supra p. 11) and the *Federico* affidavit. (n. 15, *supra* p. 11).

[20] i.e., 35 U.S.C. §§ 131, 141-146, 282.

Thus, the Fourth Circuit acknowledged that "it seems clear that the [Supreme] Court believes that patentability standards such as non-obviousness [35 U.S.C. 103] . . . have a constitutional dimension", citing *Graham, supra,* and *Anderson's-Black Rock, supra,* but dismissed as "insubstantial" petitioner's claim that § 122 is unconstitutional as applied by the Patent Office to suppress a part of the evidence requisite to insure the issuance and enforcement of only those patents that conform to the Constitution's standard.[21]

The core of this Fourth Circuit rejection of petitioner's first constitutional claim is the observation, taken verbatim from the artfully phrased *Patent Office brief,* that "*Brown* v. *Guild* (The Corn Planter Patent, 90 U.S. 181, 210, 211 (1874), holds that an abandoned application, per se, cannot be the basis for holding a patent invalid

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[21] In *Anderson's-Black Rock,* this Court reversed a 1968 Fourth Circuit decision (404 F.2d 450) to hold a patent invalid on the basis of constitutional strictures.

The reference in this case to these same strictures as only this Court's *belief* rather than an established tenet of law suggests that the Fourth Circuit is at best convinced against its will of the "constitutional dimension". This hypothesis is confirmed as to Judge Winter, author of the opinion below, by the tenor of his recent dissent in *Blohm & Voss A.G.* v. *Prudential-Grace Lines, Inc.,* 489 F.2d 231 (4 Cir. 1973), cert. den. —— U.S. —— (1974) (this issue not raised) wherein he quotes from *Graham, supra,* 383 U.S. at 17-18, but seemingly concludes, in opposition to its holding, that the ultimate legal question of patent validity under 35 U.S.C. § 103 may be foreclosed by the fact-findings of the district court.

In rejecting the constitutional claims as "insubstantial", the Fourth Circuit made no reference either to *Goosby* v. *Osser,* 409 U.S. 512 (1973) or *Hagans* v. *Lavine,* 415 U.S. 528, 39 L.Ed. 2d 577 (1974) or the strict test which these cases explicate, nor did it cite or purport to cite any "prior decisions [which] inescapably render the claims frivolous" or which "foreclose the subject and leave no room for the inference that the question sought to be raised can be the subject of controversy". *Hagans, supra,* 415 U.S. at ——, 39 L.Ed. 2d at 588.

because the application represents nothing more than an abandoned experiment" (App. A, p. 17a).[22]

The Fourth Circuit also took from the Patent Office brief and served up in rephrased form, the agency assertion that the first constitutional argument is insubstantial because "35 U.S.C. § 102 which specifies the type of prior art which will prevent issuance of a patent, . . . does not specify abandoned applications as 'prior art' " (App. A, p. 17a). No authority is cited.[23]

Petitioner's second and third constitutional claims, both of which were misstated by the Fourth Circuit, were

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[22] See the discussion, *supra*, p. 6, of *Brown's* teaching.

[23] The interpretation of § 102 as limiting the "prior art" available for consideration on the § 103 issue of "obviousness" conflicts with many decisions of other courts, including *Application of Harry*, 333 F.2d 920, 922 (CCPA 1964) and *Application of Bass*, 474 F.2d 1276 (CCPA 1973). Efforts to so limit evidence of obviousness were considered and rejected by the Congress incident the enactment of § 103. See the Hearings Before Subcommittee No. 3 of the Committee of the Judiciary, House of Representatives, 82nd Cong., 1st Sess. on HR 3760 (1951) at p. 221 and *Harry, supra*, 333 F.2d at 922, n. 1 and n. 2. This interpretation of § 102 also fails to meet petitioner's argument based on the Patent Office concession that abandoned applications "are evidence of the level of skill in the art to which they pertain as of their filing dates" (C.A. App. I, p. 35, par. 12) *even though* not public and not mentioned in § 102. See *Graham, supra*, 383 U.S. at 17.

Moreover, as the Patent Office has stipulated (App. I, Par. 18, 24, 25, 39, pp. 42-46) *publicly available*, and hence *non*-secret abandoned applications, are *prior art* references within the express contemplation of § 102(b) and applied as such in the examination of pending cases just as any other publicly available document is applied.

The judicial exclusion of "abandoned applications" from § 102 because of lack of express mention is a logical *non sequitur* in light of the lower court's gratuitous *inclusion*—essential to its Exemption 3 ruling—of the same abandoned applications in § 122, *notwithstanding lack* of express mention.

summarily dismissed as dissonant with and answered by this Court's decision in *Kewanee Oil Co.* v. *Bicron Corp.*, 412 U.S. 546 (1974)—notwithstanding the lower court's earlier acknowledgment that "There is nothing in the opinion in Kewanee to indicate that the legality of suppressing all information contained in abandoned applications was either litigated or decided" (App. A, p. 9a).

Petitioner's second constitutional claim, in essence, is that the Constitution precludes Patent Office subordination of the patent system to the state law of trade secrets and hence, that the evidence germane to patentability which abandoned applications contain may not be federally suppressed on the pretext of protecting trade secrets. This claim is seemingly in strict harmony with *Kewanee's* acknowledged "limitation on the states . . . that in regulating the area of patents and copyrights, they do not conflict with the operation of the laws in this area passed by Congress. . . ." 412 U.S. at ——, 40 L. Ed.2d at 324, which the Fourth Circuit quoted (App. A, 19a) but refused to apply.[24]

The third constitutional claim—that since the grant of trivial and undeserving patents contravenes the substantive due process standard of the Fifth Amendment by impeding the rights of all citizens to the free exercise of

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[24] It is stipulated that the Patent Office has no right under any statutory or constitutional provision or on any other basis to recognize any sort of proprietary right in subject matter which it has adjudged unpatentable (C.A. App. I, p. 48 par. 52); that "At least some patent applications are abandoned because an unfavorable adjudication of patentability has been rendered by the Patent Office . . . but even as to such applications it is customary for the Patent Office to retain them and their related files in secrecy" (C.A. App. I, p. 43, par. 28) and that the Patent Office has no "proprietary right or interest of any nature in any alleged trade secret purportedly contained in any abandoned patent application." (C.A. App. I, p. 48, par. 51).

ordinary skills in pursuit of a normal calling[25] and thereby retards rather than advances, the progress of the useful arts, in derogation of the Patent Clause, the Constitution necessarily interdicts suppression by the Patent Office of any part of the evidence germane to patentability[26]—was wholly evaded by the Fourth Circuit's misstatement of it (App. A, 18a) and is unrelated to *Kewanee* on which its rejection as "insubstantial" below was solely premised.

## REASONS WHY THIS WRIT SHOULD BE GRANTED

1. The petition in No. 74-450, *Robertson* v. *Butterfield*, citing *inter alia*, the Fourth Circuit decision below, sets forth compelling reasons why this Court should consider the question of whether a statute which confers discretion upon the administrator to make records available "specifically exempts from disclosure" within the meaning of § 552(b)(3).[27]

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[25] See *Allgeyer* v. *Louisiana*, 165 U.S. 578, 589-590 (1886); *Greene* v. *McElroy*, 360 U.S. 474 (1959).

English economic monopolies, always a paramount object of colonial resentment, were one cause of the Revolution. Every school child is familiar with the "monopoly on tea that sparked the Revolution," *Graham*, *supra*, 383 U.S. at 7, and with the excesses of the Stamp Act and the Townshend Acts. Less well known is the *List of Infringements and Violations of Rights* drawn up by the Boston Town Meeting in 1772 that complained of the English action:

> "The restraining us from erecting Stilling Mills for manufacturing our Iron the natural produce of this Country, *Is an infringement of that right with which God and nature have invested us, to make use of our skill and industry in procuring the necessaries and conveniences of life.*"

[26] *Atlantic Works* v. *Brady*, 107 U.S. 192, 199-200 (1883); *Great A&P Tea Co.* v. *Supermarket Equipment Co.*, 340 U.S. 147 (1950).

See "The Constitutional Standard of Invention—The Touchstone for Patent Reform", 1973 Utah Law Rev. 653, 667-674.

[27] To illustrate the "uncertainty and confusion in the circuit" "as to exemption 3," the petition in No. 74-450 cited (pp. 17-18) in addition to *Robertson* and *Sears, Stretch* v. *Weinberger*, 495 F.2d

The coincident presentation of this petition and that in No. 74-450 provides a rare oportunity for this Court to define precisely the reach of the FOIA's Exemption 3, in the context of two quite different statutes having different language, purposes and histories, involving basically different agencies and implementing different constitutional objectives—to wit 49 U.S.C. 1104 and 35 U.S.C. 122.

This is the *only* case of those cited in No. 74-450 in which the appellate court held the involved statute to be *within* exemption 3.[28] It is also the *only* such case in which the withheld information was initially submitted to induce the grant of a public franchise to the applicant. Joint consideration of the two cases in this Court will permit a searching elaboration of exemption 3 which jurisdictional considerations will gainsay if either case be considered alone.

An early and authoritative delineation of exemption 3's scope is important to the administration of the FOIA. Citing fragments of the legislative history, the United States, in No. 74-450 seeks a recidivist interpretation of exemption 3 which would permit agency withholding of information of "all material with respect to which Congress by statute has provided for nondisclosure on *various* terms, including statutes which give government officials *discretion* to decide whether to disclose," No. 74-450, pet. p. 2—a relapse to the very evils which it was the purpose of the FOIA to correct.[29] The Senate, in

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639 (3 Cir. 1974); *Schechter* v. *Weinberger*, 498 F.2d 1015 (9 Cir. 1974); and from the Fifth Circuit *Serchuk* v. *Weinberger*, 493 F.2d 663 (5 Cir. 1974) and *Evans* v. *Department of Transportation*, 446 F.2d 821 (1971), cert. den. 405 U.S. 918.

[28] Except to the extent that *Evans, supra*, may be relevant.

[29] The No. 74-450 petition represents that "At the time of the enactment of the FOI Act there were nearly 100 statutes which restricted disclosure in various ways. . . . These discretionary statutes differ widely . . ." (p. 9).

its May, 1974 "Freedom of Information Act Source Book: Legislative Materials, Cases, Articles" especially at pages 1 and 6-8 clearly demonstrates the true Congressional intent which is at odds with both the decision below and the position of the United States in No. 74-450.

In correctly applying the required "*strict*" construction to the § (b) (3) exemption, the District of Columbia Circuit has held that the exempting *statute* **"must itself specify"** the documents to be withheld. Thus, in *Tax Analysts and Advocates et al* v. *Internal Revenue Service*, No. 73-1978, decided August 19, 1974 (Appendix E, infra, p. 33a), the *un*animous court *quoted and reaffirmed* its prior ruling in *Robertson*, that

> "The ordinary meaning of Exemption (3) is that the statute therein referred to must *itself* specify the documents or categories of documents it authorizes to be withheld from public scrutiny."

The District of Columbia Circuit decisions in *Robertson* and *Tax Analysts* are in conflict with the Fourth Circuit's ruling in this case which purports to qualify § 122—which does *not* refer to them—as a statute by which abandoned applications are nevertheless "specifically exempted" on the ground that

> ". . . The phrase 'such special circumstances as may be determined by the Commissioner' . . . *incorporates* the *then existing administrative standards* for disclosure of patent applications embodied in Rule 14 (a) and (b). *In turn, the* [administrative] standards found in Rule 14 *are sufficiently specific* that *they* meet the 'specifically *exempting*' requirement of the (b) (3) exception." (App. A, 8a)

The decision below also conflicts with the ruling of the

Third Circuit in *Stretch* v. *Weinberger*, *supra*.[30] In *Stretch*, the court held:

> ". . . We agree, as did the district court, that *the exempting statute must prescribe* some basis upon which the Secretary is to decide. Otherwise, there would be no escape from the unacceptable conclusion that the word 'specifically', as used in section 552 (b) (3), is surplusage."

The Fourth Circuit's suggestion that its decision follows the "Third Circuit view" in *Stretch* is incorrect. The conflict is direct and obvious. There is no difference between the "unbridled discretion" which the "phrase" quoted from § 122 vests in the *Patent* Commissioner and the "unbridled discretion" ("no disclosure . . . shall be made except as the Secretary . . . may by regulation prescribe") which the Third Circuit held to *dis*qualify 42 U.S.C. 1306(a) under exemption 3.[31]

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[30] And, *a fortiori*, with the Fifth Circuit decision in *Serchuk* which adopts *Stretch*. See the No. 74-450 petition p. 17, n. 11.

The Third Circuit definitely did **not** "rule" as stated in the appellate court's opinion (App. A, —a) in this case. The portion of the Third Circuit opinion quoted below is carefully identified by *that* court as *only* a statement of what "the *plaintiffs* argue" 495 F.2d at 64.

[31] Nor is the conflict in decision obviated by the suggestion that "applications for patents" is a "category" or "class" which qualifies § 122 under § (b)(3). A "category" can have significance only if *it* is specifically and narrowly defined. In *Stretch*, the equally generic "category"—

> "any . . . report . . . obtained at any time by the Secretary . . . or employee of the Department . . . in the course of discharging their . . . duties"

did *not* qualify 42 U.S.C. § 1306(a). Practically viewed in the context of the Patent Office practice, the term "applications for patents" as generically construed below is equally broad. See also the discussion of the generalized "category" found *not* to qualify § 1104 of the Federal Aviation Act of 1950 in *Robertson*, *supra*, 498 F.2d at 1033.

2. There is a dichotomy between the Patent Office and the courts as to the evidentiary effect of abandoned patent applications in the adjudication of patentability and patent validity questions. This dichotomy is consequent from an expedient Patent Office interpretation of this Court's decision in *Brown* v. *Guild*, 90 U.S. 181, 210-211 (1874) which the courts have not adopted.

The Patent Office, emphasizing *Brown's* holding, on the specific facts at issue, that the mere filing of an unsuccessful application for a patent "cannot take the case out of the category of unsuccessful experiments" broadens its thrust to categorize abandoned applications generally as unsuccessful experiments and therefore disqualifies them as evidence of unpatentability in every context.

The courts, including this one, at least tacitly stressing *Brown's* acknowledgement that an abandoned application may "have a bearing on the question of prior invention or discovery" and hence is part of "the whole of the evidence" to be considered in assessing patent validity receive and consider such applications in litigated cases.[32]

As the Fourth Circuit conceded (App. A, 17a), this Court in *Milburn*, *supra* criticized the administrative practice based on the Patent Office interpretation of *Brown*. This Court has not heretofore had an opportunity to confront that practice squarely and rule upon its legitimacy. Yet the practice affects the whole mass of patent applications[33] examined in the Patent Office and is *a fortiori* one of several factors which account for

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[32] See e.g., *Brown* v. *Davis*, *Yale Lock*, *Altoona*, *Stelos*, *Smith* and *Package Devices*, cited *supra* n. 6, p. 5.

[33] Some idea of the magnitude is apparent from the Annual Report of the Commissioner of Patents for the fiscal year ended June 30, 1973 which shows that more than 70,000 new patent applications were filed in each of the twenty fiscal years between 1954 and 1973, with the number exceeding 100,000 in each of the four latest of these years.

the observed dichotomy between administrative and judicial patentability standards.[34]

3. 35 U.S.C. § 122, which was enacted in 1952 is in terms binding on the Commissioner of Patents but not on the courts.

Under § 122 the Commissioner has promulgated rules including 37 CFR 1.108 and 1.14 providing for absolute secrecy of abandoned applications generally and precluding their citation as references against pending applications. Presumably these rules rest upon an undisclosed administrative determination that public availability of abandoned applications is *not* "necessary to carry out the provisions of any act of Congress" (35 U.S.C. § 122) including other sections of the patent statutes embodied in Title 35. These rules are followed in the Patent Office but have no present effect upon the gathering or presentation of evidence in the courts,[35] where abandoned applications are used just like other forms of evidence in implementation of the patentability criteria of 35 USC §§ 102 and 103.

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[34] See *Graham* v. *John Deere Co., supra,* 383 U.S. at 18-19; *Kewanee Oil Co.* v. *Bicron Corp.,* 412 U.S. 546 (1974).

*Kewanee* emphasizes that "[t]his Court has noted the difference between the standards used by the Patent Office and the courts to determine patentability [citing Graham] 412 U.S. 546 at ——, and cites, as a "possible explanation" Areeda's observation that "[t]he Patent Office often seems to resolve doubts about patentability in favor of issuance. . . . Thus, the Patent Office grants many patents that will be held invalid if ever fully litigated." *Areeda,* Antitrust Analysis § 406(d) (1967).

[35] The courts routinely act to compel production for use in litigation of both pending and abandoned patent applications, notwithstanding § 122 and such rules as 37 CFR 1.108 and 1.14. See, *e.g.,* the *James B. Clow and Sons, Inc.* and *Carrier* cases cited *supra* n. 6, p. 6.

To date the rulings below represent the sole judicial effort at determining whether use of abandoned applications as evidence is "necessary to carry out" §§ 102 and 103. In effect, these rulings simply rubber stamp the administrative determination implicit in 37 C.F.R. 1.108 and 1.14. Absent review of the cases they will stand as the sole authority on the ambit of § 122 and specifically on the question of whether use of abandoned applications as evidence is necessary to the proper implementation of the high patentability standard required by these statutes.

No conflicting interpretation will emerge, as a practical matter, from appellate proceedings arising out of the Patent Office examination of pending patent applications. No patent applicant can appeal from a Patent Office decision in his favor; moreover, no patent applicant can reasonably be expected to challenge the Patent Office failure to cite *any* particular reference, whether or not an abandoned application, to defeat his own application for a patent. The Patent Office can neither challenge its own decisions nor attack its own rules before the courts and hence will certainly not raise the matter.

Nor will any conflicting interpretation be spawned by patent validity litigation. The lower courts interpret § 122, if at all, only incidentally to gaining an understanding of some aspect of Patent Office procedure or evidentiary standards. These courts have no authority to impose evidentiary standards upon the Patent Office or to require that it consider any particular class of evidence.

In short, even though § 122 and its interpretation relative to abandoned patent applications has a significant impact upon each of the applications which the Patent Office receives, an opportunity for authoritative adjudication of its scope in this Court probably will not arise again. Accordingly, to afford the proper guidance to

the Patent Office, the lower courts which may otherwise be influenced by the decisions below to discontinue using abandoned application as evidence germane to the §§ 102 and 103 patentability criteria [36] and Congress,[37] this Court should follow the admonition of *Andrews* v. *Hovey*, 124 U.S. 694, 716 (1888) that "[a] question arising in regard to the construction of a statute of the United States concerning patents for inventions cannot be regarded as judicially settled when it has not been so settled by the highest judicial authority which can pass upon the question", and *now* review the decision of the Fourth Circuit in this case.

Like *Andrews*, this case is not one "for the application of the doctrine that, in cases of ambiguity, the practice adopted by an executive department of the government in interpreting and administering a statute is to be taken as some evidence of its proper construction", 124 U.S. at 717. The interpretation of § 122 "is not a question of executive administration, but is properly a judicial question" governing as it does the application and use of an important segment of evidence germane to patentability. Hence, even though it "may come under the cognizance of the commissioner of patents, in granting a patent, yet, like all the questions passed upon by him

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[36] As shown in the petition in No. 74-207, *Akron Presform Mold Co.* v. *McNeil Corp.*, filed August 28, 1974 at pp. 14-15 the Patent Office concealment of abandoned applications may in some cases abet the owner of an abandoned application in defrauding, misleading or otherwise inequitably prejudicing an opponent in subsequent litigation.

[37] The district court decision has already been cited to Congress as authority for unfavorable action on S.1321, 93rd Cong., 1st Sess., providing for public availability of heretofore abandoned patent applications and prompt publication prior to issuance of subsequently filed applications as part of a new examination system with opportunity for public participation and presentation of evidence. See, *e.g.*, Hearings Before the Subcommittee on Patents, Trademarks and Copyrights, Committee on the Judiciary, United States Senate, 93rd Cong., 1st Sess. (1973) at pp. 600, 604-605.

in granting a patent, . . . his determination thereof . . . has never been looked upon as concluding the determination of the courts in regard to those questions. . . ." *Andrews, supra,* at 718. To insure that his interpretation does not become conclusive by default, the decision below should be reviewed now.

4. Question 2 concerning the proper interpretation of this Court's precedent and Question 3 concerning the proper interpretation of 35 U.S.C. § 122, were resolved by the Fourth Circuit in a way that promotes divergence between Patent Office and judicial precedent by leaving intact the conflicting evidentiary rules of each even though the appellate court perceived a "tendency to hamper the correct resolution of constitutional issues. . . ." (App. A, 18a) in this result.

This Court in *Graham, supra,* explicating the high standard for patentable invention, emphasized that the constitutional structures bind Congress and the lower courts and implied that they bind the administrative branch as well by noting a need for "closer concurrence between administrative and judicial precedent." 383 U.S. at 18. This case presents a pointed example of that need and emphasizes the inability of both the Patent Office and the lower courts to achieve "concurrence" without guidance from this Court.

This Court recognized in *Graham, supra,* that "the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system." (383 U.S. at 18). The decision of the Fourth Circuit is that whenever an abandoned application is part of the evidence germane to patentability, the public *must* await litigation to have it considered.[38]

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[38] Practically it may not be considered even then since there is no ready way of locating abandoned applications so long as the

No effort was made to harmonize this decision with the Court's further admonition in *Graham* "for the Commissioner to adhere strictly to the 1952 Act as interpreted here" (383 U.S. at 18) or to gauge its debilitating effect upon the patent system as a whole. Yet current statistics show that *Graham* is largely ignored by the Patent Office—and strongly imply that it will be further disregarded if Patent Office practices which encourage only partial consideration of evidence germane to patentability, including that approved by the decision below—are allowed to stand.[39] The 1973 Annual Report of the Commissioner of Patents shows that the number of patents granted annually has increased from the "about 50,000" noted in *Graham*, 383 U.S. at 18, to about 70,000 in each of 1971 and 1973 and over 80,000 in 1972. BNA's Patent, Trademark and Copyright Journal on September 13, 1973 published statistics showing that the United States Patent Office grants 75-80% of all applications

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Patent Office keeps them secret. The result is that a litigant will have a fair chance at discovering relevant abandoned applications owned or controlled by his opponent but must trust to luck to find those in third party hands.

[39] Contrary to *Graham's* mandate, the Patent Office quota system subordinates quality to quantity to meet a production goal. In commenting on this system, Murray Weissman, primary Examiner with "close to 29 years experience in patent examination" testified on September 14, 1973

> "It should hardly surprise anyone that the Patent Office, operating under present practices and procedures, is at least one of the prime causes for patent invalidity. There is also hardly any question that some of the practices are a result of the demands made upon the Patent Office with respect to decreasing, or at least maintaining at the same level, the backlog of unexamined applications. But the question here is simply whether or not there can be any justification for the practices and procedures employed by the Patent Office in order to meet the demands made, regardless of what they may be, when it is glaringly apparent that they must inevitably result in a flood of invalid patents."

See Hearings cited *supra* n. 37, p. 25, at pp. 445-447.

filed in contrast to the 30% rate of patent issuance in West Germany and the 40% rate in Japan.[40]

The public interest is in a Patent Office which functions to sift out unpatentable material at the source.[41] This case is unusual in that it affords this Court an opportunity to instruct the Patent Office directly on this point—hence the public interest augurs strongly in favor of accepting the case for review.

## CONCLUSION

The present petition for writ of certiorari should be granted.

Respectfully submitted,

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[40] Pointedly, West Germany and Japan are showing marked signs of soon outstripping the United States in technological progress—and each enforces a much higher standard of patentability at the Patent Office level than does the United States.

[41] This is so not only because of the dominant public interest which underlies the very existence of the patent system but also because the Patent Office operation is paid for by public subsidy so that as a practical matter, the Office should be obligated to serve the public rather than the patent applicant. For example, in fiscal 1973, according to the Annual Report of the Commissioner of Patents, the Patent Office operation cost $64,500,000 and the Patent Office income from fees was $26,000,000 leaving a deficit of $38,-500,000 to be made up from public funds.